Application No. 09/736,899
Reply to Advisory Action mailed March 17, 2004

Patent
Attorney Docket No. CU-2415

II. REMARKS/ARGUMENTS

A. General

In the Advisory Action mailed March 17, 2004, the Examiner held that the Reply to Final Action filed March 1, 2004 by the Applicant did not place the application in condition for allowance, and that the Final Office Action dated December 31, 2003 was proper.

The Applicant would like to thank the Examiner for taking the time to conduct a telephonic Examiner Interview with the Applicant's Agent of Record, as well as with the Applicant's Canadian representative, on March 23, 2004. In the end, the Examiner maintained that the combination of US Patent Application Publication No. 2002/0016921 (Olsen) and US Patent Application Publication No. 2003/0137685 (Meade, II) discloses all of the limitations of claims 47-80.

The present amendment has been prepared in reply to both the Final Office Action dated December 31, 2003 and the Advisory Action dated March 17, 2004, and particularly in order to address the comments and arguments raised by the Examiner during the telephonic Examiner Interview of March 23, 2004.

B. Summary of the Amendments

The application still contains claims 29-45 and 47-80, claims 29-45 having been withdrawn from consideration.

During a follow-up telephone conference with Applicant's Agent of Record on March 23, 2004, the Examiner indicated that limitation b) of claim 47 is phrased in functional language showing only the intended use. With respect, the Applicant refers the Examiner to MPEP 2173.05(g), which states that "[t]here is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. *In re* Swinehart, 439 F.2d 210, 169

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USPQ 226 (CCPA 1971)." Moreover, the Applicant respectfully submits that the functional language in claim 47 clearly defines the functionality of the processing unit and thus clearly defines the boundaries on the patent protection sought (*In re* Barr, 444 F.2d 588, 170 USPQ 33 (CCPA 1971)). Accordingly, the Applicant respectfully submits that limitation b) of claim 47 is in no need of amendment.

Nonetheless, in the interest of advancing prosecution, claim 47 has been amended in order to remove the expression "operative to". Similar amendments have been made to claims 63 and 79.

Claims 48 and 64 have been amended in order to correct a minor informality detected by the Applicant upon reviewing the application.

Claims 53, 60, 61, 69, 76 and 77 have been amended in order to correct the claim dependency.

It is respectfully submitted that no new matter has been added to the application under the present amendment.

C. Summary of Rejections and Reply

35 USC 112

On page 2 of the Final Office Action dated December 31, 2003, the Examiner has rejected claims 60, 61, 76 and 77 under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. More specifically, the Examiner stated that, in claims 60 and 76, the recitation "said device analysis unit is operative to generate a third control signal" renders the claims indefinite and unclear since first and second control signals have not been previously generated. Similarly, the Examiner stated that, in claims 61 and 76 (*sic*, intended to be 77), the recitation "said device analysis unit is operative to generate a fourth control signal" renders the

claims indefinite and unclear since second and third control signals have not been previously generated.

In response, the Applicant has amended claims 60, 61, 76 and 77 in order to change their respective claim dependency. The respective claim dependency of claims 60 and 76 is now such that first and second control signals have been previously introduced. Similarly, the respective claim dependency of claims 61 and 77 is now such that second and third control signals have been previously introduced.

The amendments made to claims 60, 61, 76 and 77 are believed to have fully addressed and overcome the Examiner's rejection of these claims. Accordingly, the Applicant respectfully submits that claims 60, 61, 76 and 77 as amended are now in full compliance with 35 USC 112, second paragraph.

35 USC 103

On page 3 of the Final Office Action, the Examiner has rejected claims 47-80 under 35 USC 103(a) as being unpatentable over U.S. Patent Application No. 2002/0016921 (hereinafter referred to as "Olsen") in view of U.S. Patent Application No. 2003/0137685 (hereinafter referred to as "Meade, II"). As set forth below, the Applicant respectfully disagrees and submits that claims 47-80 distinguish clearly and patentably over the cited art.

Independent claim 47

The Examiner's attention is directed to the following limitations of claim 47:

"A disbursement tracking system (...) comprising:
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b)   a processing unit coupled to said input for:
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iii)   determining a status of the output device on a basis of said device information, said status including an indication of a cost allocation data requirement of the output device;

iv) **processing** said print job file **on a basis of the cost allocation data** requirement of the output device, for ensuring that said print job file is in condition for printing by the output device;

It is respectfully submitted that the combination of Olsen and Meade, II does not explicitly disclose nor implicitly suggest the invention claimed in claim 47, as discussed below.

By way of introduction, the present invention as claimed is directed to a disbursement tracking system that controls the usage of an output device by determining a cost allocation data requirement of the output device. As described in the specification, the expression "cost allocation data requirement" refers to the fact that the output device either (i) must receive cost allocation data (e.g. user identification codes and/or passwords, client names and/or matters, billing codes, etc.) prior to being able to perform a print job; or (ii) does not need to receive cost allocation data prior to being able to perform a print job. Thus, the disbursement tracking system determines whether the output device requires or does not require cost allocation data in order to perform a print job. An attempt by a user to print a document on the output device is treated differently by the disbursement tracking system depending on whether or not the output device requires cost allocation data for performing a print job.

Turning now to the cited art, the combination of Olsen and Meade, II does not explicitly disclose nor implicitly suggest the claimed disbursement tracking system.

Firstly, as conceded by the Examiner on page 4 of the Final Office Action Olsen does not disclose "determining a status of the output device[, the status] including an indication of a cost allocation data requirement of the output device". As further conceded by the Examiner, Olsen also does not disclose "processing the print job file on the basis of the cost allocation data requirement of the output device", for ensuring that the print job file is in condition for printing by the output device.

Secondly, it is respectfully submitted that Meade, II does not disclose, each nor suggest the above-mentioned limitations of claim 47, already conceded by the Examiner to be missing from Olsen. Specifically, Meade, II does not disclose, teach nor suggest either of (1) "determining a status of the output device on a basis of [the] device information, [the] status including an indication of a cost allocation data requirement of the output device"; and (2) "processing [the] print job file on a basis of the cost allocation data requirement of the output device, for ensuring that [the] print job file is in condition for printing by the output device".

Rather, Meade, II describes an apparatus for monitoring usage of consumables (e.g. paper and toner) at an image forming device in order to establish the cost of consumable resources that are utilized for any particular print job executed by the image forming device (paragraph/box 27, lines 5-11). The apparatus of Meade, II is totally unconcerned with the existence or non-existence of a cost allocation data requirement for any particular image forming device on which a print job s to be executed. Specifically, the apparatus of Meade, II monitors usage of consumables at an image forming device without giving any consideration to whether or not the particular image forming device requires cost allocation data in order to perform a print job (paragraphs/boxes 54 to 59). In other words, Meade, II does not determine a requirement of the image forming device with respect to cost allocation data. Clearly, therefore, Meade, II does not disclose, teach nor suggest the claimed limitation of "determining a status of the output device[, the] status including an indication of a cost allocation data requirement of the output device".

In the Interview Summary mailed March 24, 2004, the Examiner contends that paragraph/box 30 of Meade, II discloses "determining a status of the output device[, the] status including an indication of a cost allocation data requirement of the output device". The Applicant respectfully disagrees with this assessment and submits that paragraph/box 30 of Meade, II, like Meade, II as a whole, does not disclose, teach nor suggest determining a status of the output device, the status including an indication of a cost allocation data requirement of the output device.

Rather, paragraph/box 30 of Meade, II describes that Meade, II's apparatus "enables specific determination of *where costs have been incurred* simply by determining *which image forming device* 12 has fused toner onto one or more sheets of paper" (emphasis added, paragraph/box 30). In other words, Meade, II's apparatus determines which specific image forming device has incurred the costs associated with a given print job by determining which specific image forming device, out of a plurality of image forming devices, has performed fusing of toner onto paper.

This determination of the specific image forming device on which costs have been incurred in no way relates to a determination of a status of a particular output device, let alone a status including an indication of a <u>cost allocation data requirement of that particular output device</u>. That is, while Meade, II describes determining which particular image forming device performed a print job in order to be able to associate the incurred costs for that print job to the particular image forming device, Meade, II in no way makes a determination as to whether or not the particular image forming device requires cost allocation data prior to being able to perform the print job. Thus, as is the case for Meade, II as a whole, there is absolutely no mention or suggestion in paragraph/box 30 of Meade, II as to a determination of a <u>cost allocation data requirement</u> of an image forming device.

It is therefore clear that Meade, II as a whole, including the particular passage referred to by the Examiner, does not disclose, teach nor suggest a first limitation of claim 1, namely "determining a status of the output device[, the] status including an indication of a cost allocation data requirement of the output device".

Moreover, since it does not teach or suggest determining a cost allocation data requirement of an image forming device, Meade, II cannot possibly be held to teach or suggest processing a print job on the basis of such a cost allocation data requirement. In fact, as described above, the apparatus of Meade, II always processes a print job in the same manner (i.e. monitors and reports consumables usage at the image forming device) regardless of a cost allocation data requirement of the particular image forming device on which the print job is to be executed. Thus,

Meade, II cannot be held to teach or suggest a second limitation of claim 47, namely "processing [the] print job file on a basis of the cost allocation data requirement of the output device, for ensuring that [the] print job file is in condition for printing by the output device".

In light of the foregoing, it is respectfully submitted that at least one limitation of independent claim 47 is neither taught nor suggested by the cited art, whether taken separately or in combination. Therefore, the Applicant respectfully submits that at least one criterion required for establishing a *prima facie* case of obviousness in accordance with MPEP 706.02(j) has not been satisfied[1].

Accordingly, the subject matter of claim 47 is believed to be novel and non-obvious over the cited art and, as such, in condition for allowance. The Examiner is respectfully requested to withdraw the rejection of claim 47 under 35 USC 103(a).

Dependent claims 48-62

Claims 48-62 depend either directly or indirectly on claim 47 and therefore include all of the limitations of claim 47. Hence, for the same reasons as those set forth herein above in respect of claim 47, the Applicant respectfully submits that claims 48-62 distinguish clearly and patentably over the cited art, such that they are also believed to be in condition for allowance. The Examiner is thus respectfully requested to withdraw the rejection of claims 48-62.

Independent claim 63

The Examiner's attention is directed to the following limitations of claim 63:

"A computer readable storage medium containing a program element for execution by a computing apparatus to implement a disbursement tracking system (...), said disbursement tracking system including:

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[1] For the Examiner to establish a *prima facie* case of obviousness, three criteria must be considered: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings, (2) there must be a reasonable expectation of success, and (3) the prior art references must teach or suggest all of the claim limitations. MPEP §§ 706.02(j), 2142 (8th ed.).

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b) a processing unit coupled to said input for:

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    iii) determining a status of the output device on a basis of said device information, said status including an indication of a cost allocation data requirement of the output device;

    iv) processing said print job file on a basis of the cost allocation data requirement of the output device, for ensuring that said print job file is in condition for printing by the output device;

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It is respectfully submitted that the combination of Olsen and Meade, II does not explicitly disclose nor implicitly suggest the invention claimed in claim 63.

Specifically, for the same reasons as those set forth herein above in respect of claim 47, neither Meade, II nor Olsen teaches or suggests either of (1) "determining a status of the output device on a basis of [the] device information, [the] status including an <u>indication of a cost allocation data requirement of the output device</u>"; and (2) "processing [the] print job file <u>on a basis of the cost allocation data requirement of the output device</u>, for ensuring that [the] print job file is in condition for printing by the output device".

Accordingly, the Applicant respectfully submits that the subject matter of claim 63 is novel and non-obvious over the cited art and, as such, in condition for allowance. The Examiner is respectfully requested to withdraw the rejection of claim 63.

Dependent claims 64-78

Claims 64-78 depend either directly or indirectly on claim 63 and therefore include all of the limitations of claim 63. Hence, for the same reasons as those set forth herein above in respect of claim 63, the Applicant respectfully submits that claims 64-78 distinguish clearly and patentably over the cited art, such that they are also believed to be in condition for allowance. The Examiner is thus respectfully requested to withdraw the rejection of claims 64-78.

Independent claim 79

The Examiner's attention is directed to the following limitations of claim 79:

> A disbursement tracking system (...) comprising:
>
> b) processing means coupled to said input means for:
>
>   iii)   determining a status of the output device on a basis of said device information, said status including an indication of a cost allocation data requirement of the output device;
>
>   iv)   processing said print job file on a basis of the cost allocation data requirement of the output device, for ensuring that said print job file is in condition for printing by the output device;

It is respectfully submitted that the combination of Olsen and Meade, II does not explicitly disclose nor implicitly suggest the invention claimed in claim 79.

Specifically, for the same reasons as those set forth herein above in respect of claim 47, neither Meade, II nor Olsen teaches or suggests either of (1) "determining a status of the output device on a basis of [the] device information, [the] status including an indication of a cost allocation data requirement of the output device"; and (2) "processing [the] print job file on a basis of the cost allocation data requirement of the output device, for ensuring that [the] print job file is in condition for printing by the output device".

Accordingly, the Applicant respectfully submits that the subject matter of claim 79 is novel and non-obvious over the cited art and, as such, in condition for allowance. The Examiner is respectfully requested to withdraw the rejection of claim 79.

Independent claim 80

The Examiner's attention is directed to the following limitations of claim 80:

> "A method for controlling the usage of an output device, said method comprising:
>
> d)   determining a status of the output device on a basis of said device information, said status including an indication of a cost allocation data requirement of the output device;
>
> e)   processing said print job file on a basis of the cost allocation data requirement of the output device, for ensuring that said print job file is in condition for printing by the output device;

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It is respectfully submitted that the combination of Olsen and Meade, II does not explicitly disclose nor implicitly suggest the invention claimed in claim 80.

Specifically, for the same reasons as those set forth herein above in respect of claim 47, neither Meade, II nor Olsen teaches or suggests either of (1) "determining a status of the output device on a basis of [the] device information, [the] status including an indication of a cost allocation data requirement of the output device"; and (2) "processing [the] print job file on a basis of the cost allocation data requirement of the output device, for ensuring that [the] print job file is in condition for printing by the output device".

Accordingly, the Applicant respectfully submits that the subject matter of claim 80 is novel and non-obvious over the cited art and, as such, in condition for allowance. The Examiner is respectfully requested to withdraw the rejection of claim 80.
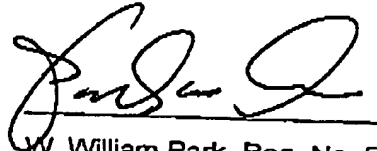
III. CONCLUSION

In view of the foregoing, the Applicant is of the view that claims 47-110 are in allowable form. Favorable reconsideration is requested. Early allowance of the Application is earnestly solicited.

If the claims of the application are not considered to be in full condition for allowance, for any reason, the Applicant respectfully requests the constructive assistance and suggestions of the Examiner in drafting one or more acceptable claims pursuant to MPEP 707.07(j) or in making constructive suggestions pursuant to MPEP 706.03 so that the application can be placed in allowable condition as soon as possible and without the need for further proceedings.

Respectfully submitted,

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Date: June 21, 2004

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